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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,019	01/11/2002	Jean-Francois Courtoy	78200-040	5197

7590 04/29/2005

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,019	COURTOY ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30,33,37-45,47,50-52,54 and 56-58* is/are pending in the application.

4a) Of the above claim(s) *1-30 and 37-45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33,47,50-52,54 and 56-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The 112 claim rejections are maintained.
2. The art rejections over Brossman et al (US 6,613,256) as evidenced by Eby et al (US 5,961,903) are withdrawn in view of the present arguments. Brossman does not teach a surface covering wherein the printing ink comprises a photoinitiator. However, upon further consideration, new ground of rejection is made in view of Brossman et al (US 6,613,256) and Rutsch et al (US 5,147,901).
3. Canceled claims 31, 32, 34-36, 46, 48, 49, 53 and 55 are considered non-compliant because the text is present in a canceled claim. The text should be removed from the canceled claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 33, 47, 50, 51, 54, and 56-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recited the portion of the cured layer coating disposed over the optional second ink is chemically embossed; however, the recitation is not fully supported in the present specification. Nowhere in the specification discloses that the cured layer over the first ink is chemically embossed. The 112 claim rejections have been maintained for

the following reasons. Applicants argue that the specification describes chemical embossing by means of the inhibitor in the printing ink. Upon thoroughly reviewing Applicants' specification, it is recognized that ink with an expansion inhibitor is used to chemically emboss the foam layer, **not** the wear layer. Therefore, the 112 claim rejections are sustained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 33, 47, 50-52, 54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brossman et al (US 6,613,256) in view of in view of Rutsch et al (US 5,147,901). Since a second ink and a third ink are not required components of the surface covering, any limitations associated with them are excluded from the claims. Brossman discloses a synthetic covering comprising a substrate 6, a foamed plastic layer overlaying 14 the substrate 6, a first ink 16 containing an expansion inhibitor on the foam layer (figure 4). Brossman teaches a wear layer 18, a polyurethane top coat 20 overlaying the foam layer and the ink wherein the portion of the cured layer disposed over the first ink is mechanically embossed with a textured surface (column 8, lines 20-25, column 1, lines 30-36). The portion of the wear layer not disposed over the first ink 16 or the foamed regions is smooth as shown in figures 3 and 4. Brossman discloses that the "foamed regions" correspond

to "up areas" of the chemical embossing and the "non-foamed regions" correspond to "down areas" of the chemical embossing (column 3, lines 24-27). Likewise, the portion of the wear layer over the non-foamed regions is chemically embossed. Brossman teaches the wear layer overlying the foamed and non-foamed regions are independently predominately textured. The wear layer overlying the foamed regions is predominately textured first and subsequently the wear layer overlying the unfoamed regions is predominately textured (column 4, lines 27-40, and claim 3). The mechanically embossed texture is wood, tile, brick or stone (column 1, lines 30-35). Brossman does not disclose the first ink containing a photoinitiator. Rutsch, however, teaches a printing ink used in floor coverings containing propiophenones as a photoinitiator to provide an improved stability on storage and increased resistance to yellowing (abstract, column 8, lines 14-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ propiophenones as a photoinitiator in the printing ink motivated by the desire to provide the printing ink having increased resistance to yellowing.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 33, 50-52, 54, and 56-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. 10/321,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending Application No. 10/321,617 fully encompass the presently claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 47 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. 10/321,617 in view of Brossman et al (US 6,613,256). Claims of copending Application No. 10/321,617 do not specifically disclose the mechanically embossed texture is ceramic tile, stone, wood or brick. Brossman, however, discloses a surface covering having textured surfaces patterned to duplicate a look of actual wood, tile, brick to provide attractive decorative surface coverings (column 1, lines 33-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ ceramic tile, stone, wood or brick as a mechanically embossed texture motivated by the desire to provide attractive decorative surface coverings.

This is a provisional obviousness-type double patenting rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

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